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09/894,476	06/28/2001	Andrew Comas	72167.000564	5938

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EXAMINER
GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
3692	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 October 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-12 remained pending in this application.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-9, are rejected under 35 U.S.C. 101 because the claimed invention is
directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the
technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature,
natural phenomena) that do not apply, involve, use or advance the technological
arts fail to promote the "progress of science and the useful arts" (i.e., the physical
sciences as opposed to social sciences, for example) are found to be non-
statutory subject matter. For a process claim to pass muster, the recited process
must somehow apply, involve, use, or advance the technological arts. In the
present case, claims 1-9, do not recite any structure or functionality to suggest
that a computer performs the recited claims. Thus, claims 1-9, are rejected as
being directed to non-statutory subject matter.

Applicant's is advised to imbed a computer in the body of the claims.

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

4.   Claims 1-12, are rejected under 35 U.S.C. 102(b) as being anticipated by
Sandretto U.S Patent 5, 812, 988).

As per claim 1, Sandretto discloses a method for structured development
of migration options in a legacy transactional enterprise, the method comprising:
identifying components of the legacy enterprise;
developing risk factors for the components of the legacy enterprise; identifying
unmet opportunities;
developing risk factors for the unmet opportunities; identifying potential
components for the legacy enterprise (see column 8 lines 52-67 and column 9-11
lines 1-67 and column 12 lines 1-55) developing risk factors for the potential
components of the legacy enterprise; and developing the migration options with
associated risks using at least the risk factors for the components, the risk factors
for the unmet opportunities and the risk factors for the potential
components.(Note abstract and see column 14 lines 31-67 and column 15-28
lines 1-67)

As per claim 2, Sandretto discloses wherein the components of the
legacy enterprise are selected from the group consisting of hardware or software.
(Note abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

As per claim 3, Sandretto discloses wherein the unmet opportunities are
selected from the group consisting of new hardware, new software or new
business methods. (Note abstract and see column 14 lines 31-67 and column 15-
28 lines 1-67).

As per claim 4, Sandretto discloses wherein the potential components for the
legacy enterprise are selected from the group consisting of hardware or software.
(Note abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

As per claim 5, Sandretto discloses wherein the potential components for the
legacy enterprise include conceptual models of undeveloped capabilities. (Note
abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

As per claim 6, Sandretto discloses wherein the risk factors include multiple variables. (Note abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

As per claim 7, Sandretto discloses wherein the risk factors are selected from the group consisting of cost or schedule. (Note abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

As per claim 8, Sandretto discloses wherein the migration options with associated risk factors are selected from the group consisting of existing components or conceptual models of undeveloped capabilities. (Note abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

As per claim 9, Sandretto discloses wherein the associated risks of the migration options are derived from the risk factors for the components of the legacy enterprise, the risk factors for the unmet opportunities, and the risk factors for the potential components of the legacy enterprise. (Note abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

As per claim 10, Sandretto discloses computer executable software code transmitted as an information signal, the code for structured development of migration options in a legacy transactional enterprise, the code comprising: code to capture identity of components of the legacy enterprise; code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities(see column 8 lines 52-67 and column 9-11 lines 1-67 and column 12 lines 1-55) code to capture risk factors for the unmet opportunities; code to capture identity of potential components for the legacy enterprise(see column 8 lines 52-67 and column 9-11 lines 1-67 and column 12 lines 1-55) code to capture risk factors for the potential components of the legacy enterprise; and code to develop the migration options with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components. (Note abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

As per claim 11, Sandretto discloses a computer-readable medium having computer executable software code stored thereon, the code for structured development of migration options in a legacy transactional enterprise, the code comprising:

code to capture identity of components of the legacy enterprise;

code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities(see column 8 lines 52-67 and column 9-11 lines 1-67 and column 12 lines 1-55) code to capture risk factors for the unmet opportunities;

code to capture identity of potential components for the legacy enterprise(see column 8 lines 52-67 and column 9-11 lines 1-67 and column 12 lines 1-55) code to capture risk factors for the potential components of the legacy enterprise; and code to develop the migration options with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components. (Note abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

As per claim 12, Sandretto discloses a programmed computer for structured development of migration options in a legacy transactional enterprise, comprising:

a memory having at least one region for storing computer executable program code; and a processor for executing the program code stored in the memory; wherein the program code comprises:

code to capture identity of components of the legacy enterprise(see column 8 lines 52-67 and column 9-11 lines 1-67 and column 12 lines 1-55) code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities;

code to capture risk factors for the unmet opportunities(see column 8 lines 52-67 and column 9-11 lines 1-67 and column 12 lines 1-55) code to capture identity of potential components for the legacy enterprise;

code to capture risk factors for the potential components of the legacy enterprise;

and code to develop the migration options with associated risks using at least the risk

factors for the components, the risk factors for the unmet opportunities and the risk

factors for the potential components. (Note abstract and see column 14 lines 31-67 and column 15-28 lines 1-67).

Conclusion

RESPONSE TO RGUMENTS

5. In response to Applicant's arguments"as it pertains to the 101 rejection"

However claims 1-9, identifying, developing, are mere abstract idea because it does not produce a tangible result.

Claims 1-9, represents a process and does not have a clear "end" or output hence ----- these claims does not produce a tangible result.

Deficiencies under the "useful invention" requirement
of 35 U.S.C. 101 will arise in one of two forms.
The first is where it is not apparent why the invention
is "useful." This can occur when an applicant fails to
identify any specific and substantial utility for the
invention or fails to disclose enough information
about the invention to make its usefulness immediately
apparent to those familiar with the technological
field of the invention.(MPEP 2107.01).

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the   examiner should be directed to Clement B Graham whose telephone

number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

March 26, 2007

FRANTZY POINVIL
PRIMARY EXAMINER